

IPW



PATENT
Customer No. 22,852
Attorney Docket No. 05788.0399-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re National Stage of International Application No.)
PCT/EP2003/014917 under 35 U.S.C. § 371 of:)
Giulia PIETRA, et al.) Group Art Unit: 2828
Application No.: 10/584,507) Examiner: King, Joshua
371 Date: June 23, 2006) Confirmation No.: 4568
PCT Filed: December 24, 2004)
For: **TUNABLE RESONANT GRATING FILTERS**)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated July 3, 2007, the Examiner required restriction under 35 U.S.C. §§ 121 and 372 between "Group 1, claim(s) 16-21, drawn to an external cavity tunable laser, classified in 372," and "Group 2, claim(s) 22-30, drawn to an optical filter, classified in 349." Applicants provisionally elect to prosecute Group 1, claims 16-21 drawn to external-cavity tunable laser systems with traverse.

Applicants traverse the restriction requirement on the grounds that the Examiner has not met his burden to justify a restriction requirement. The Examiner has argued the two inventions do not relate to a single general inventive concept in view of U.S.

Patent No. 6,999,156 to *Chou*. Applicants disagree with the Examiner's characterization of the claims and the teachings of *Chou*.

Further, while the Examiner has argued the two Groups do not relate to a single general inventive concept under PCT Rule 13.1, nowhere has the Examiner asserted that there is a serious burden in examining all of the claims at once. *Applied Materials Inc. v. Advanced Semiconductor Materials*, 40 U.S.P.Q.2d 1481, 1492 (Fed. Cir. 1996). In fact, "[i]f the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803 (emphasis added). Applicants submit that there is no additional burden to examining all of the claims at once.

Accordingly, Applicants submit that the Examiner's restriction requirement is improper and should be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 31, 2007

By: Krystyna Colantoni
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